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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,316	05/26/2000	Pierre Girard	100954-001	9687

7590

04/10/2002

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

11

DATE MAILED: 04/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-11

Office Action Summary

Application No.

09/508,316

Applicant(s)

GIRARD ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed January 17, 2002.

Claims 1-6 were amended and claims 7-8 were added rendering claims 1-8 pending.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. 4,298,652).

4. Suzuki discloses a method of producing coated paper for gravure printing, where the paper is fiber based and the coating comprises pigments containing calcium carbonate (abstract and column 2, lines 35-42) where the paper consists of a double coating (abstract). Suzuki teaches calendering the paper (column 1, line 68). Suzuki discloses a coating composition containing ground calcium carbonate and using a size press in the paper making process (column 4, lines 12-19) and the base paper is multiple-coated by means of a coater with a coating weight above 2 g/m² (column 7, lines 26-31). The reference discloses the coating composition forming each layer in multiple coating may be changed suitably and may be done by any process and by

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means of any conventional coating machines (column 7, lines 33-36). Suzuki discloses dry coating weight (column 8, line 42) and pigment in the coating composition consisting of kaolin (column 11, lines 31-32). Suzuki does not explicitly disclose the use of *precipitated* calcium carbonate or *calcined* kaolin. It would have been obvious to one of ordinary skill in the art to include the precipitated calcium carbonate and calcined kaolin in the coating of gravure printed paper because these materials comprised in coatings are well known in the art of coated paper and are analogous to ground calcium carbonate and kaolin.

Claim Rejections – 35 USC § 103(a)

5. Claims 2 and 8, are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. 4,298,652) in view of Li (U.S. 6,183,844).

6. Suzuki is relied upon for claims 1, 3-7. Suzuki does not disclose the interior coating consisting of silica.

Li teaches a printing medium suitable for inkjet printing comprising a substrate having at least two coatings applied sequentially (abstract) where the interior coating may be comprised with the same materials or different materials from the exterior coating (column 13, lines 41-44) consisting of particles (column 14, lines 6-9). Li teaches these particles consist of silica and other particles (column 14, lines 39) and colloidal silica (column 15, line 14). The interior coating consists of silica and the exterior coating consists of one of the other materials cited. Although Li does not teach gravure or flexographic printing, Applicant claims "a paper and a board consisting of a fibrous medium coated with at least one conventional surface coat *intended* to be printed by gravure or flexographic printing." Although the invention may be *intended* to be printed by gravure or flexographic printing, the invention is based on a coated paper and not

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what the coated paper is intended to be printed with. This limitation of the claim(s) offers no positive level of criticality to the coated paper, absent any showing of unexpected results.

Suzuki and Li are analogous art because they are from the same field of printing mediums. It would have been obvious to one of ordinary skill in the art to include the interior coating of Suzuki consisting of silica because Li teaches coated interior layers of printing mediums are known in the art and soften the coated material to make it more flexible.

7. Nakanishi et al. (U.S. 6,280,830) is cited as being relevant to pointing out analogous components of pigments.

Response to Arguments

8. Applicant's arguments of rejection under 35 USC 112 have been overcome due to amendment. Applicant's arguments of rejection under 35 USC 102(B) as being anticipated by Miyamoto (U.S. 4,440,827) and 35 USC 103(a) as being unpatentable over Miyamoto are rendered moot based on new grounds of rejection.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

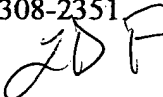
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)

308-2351


Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

